

REMARKS

Entry of this response is proper under 37 CFR §1.116; since no new claims or issues are presented herein.

Claims 1-24 are all the claims presently pending in the application.

It is noted that the claim amendments, if any, are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-19 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0143469 to Alexander, et al., in view of US Patent No. 6,985,872 to Benbassat et al. Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander/Benbassat, further in view of the Examiner's Official Notice. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander/Benbassat, further in view of U.S. Patent Publication No. 2004/0260703 to Elkins. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander/Benbassat, further in view of U.S. Patent No. 7,448,079 to Tremain.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

As described in, for example, independent claim 1, the claimed invention is directed to a method of calculating a risk exposure for a disaster recovery process. A user interface is loaded into a memory, the user interface allowing control of an execution of one or more risk models, each of the risk models based on a specific disaster type, each risk model addressing a recovery utilization of one or more specific assets identified as necessary for a recovery process of the disaster type. One of the risk models is executed at least one time thereby providing a risk according to the risk model that is executed.

As described beginning at line 10 of page 1 of the specification, the conventional disaster recovery service, as referring to a business that provides computer facilities to contracted customers who seek recovery services following a disaster, currently has no known methods to estimate the frequencies that disaster will strike its clients and how often

such customers will declare a disaster.

The claimed invention, on the other hand, provides an objective method for estimating such risks, including an objective manner to plan location and amounts of assets at recovery centers.

II. THE PRIOR ART REJECTIONS

The Examiner alleges that Alexander, as modified by Benbassat, renders obvious the claimed invention defined by claims 1-19 and 23, and, when further modified by Official Notice, renders obvious claims 20 and 21, and when further modified by Tremain, renders obvious claim 24.

Applicant again respectfully submits that the rejection currently of record fails to establish a *prima facie* obviousness rejection, for the reasons described below.

The Alexander-Based Rejections

Primary reference Alexander, et al., describes a method for collecting data in real time from multiple locations after a disaster event has occurred, integrating the data into a geographical database, and using the data and database to assess damage and to support decision making by emergency management agencies in response to a disaster event.

Applicants again point out that this method of Alexander is a very different application from that of the claimed invention.

Specifically, Alexander deals with "disaster recovery" as a single episode of recovery after a disaster has occurred, while the present invention is concerned with the continuous operation of a "disaster recovery service", as is clearly defined in paragraph 5 of the specification. Primary reference Alexander actually has very little in common with the claimed invention, including even the independent claims alone.

More specifically, in order to modify primary reference to satisfy the plain meaning of the claim language of even independent claim 1, the Examiner has the initial burden of providing a reasonable motivation to modify the method of Alexander from that of "collecting data in real time from multiple locations after a disaster event and integrating that data and making it available for emergency management agencies" into a computerized tool "... *executing, at least one time, one of said risk models*" (e.g., final limitation of independent claim 1) in order to perform the "... *method of calculating a risk exposure for a disaster recover process*", as defined in the preamble of independent claim 1.

In making such necessary modification to primary reference Alexander, the fundamental processing of Alexander of data collecting, integration, and presentation would have to be completely revised to execute a risk model at least one time.

Applicants have not been able to find reasonable support in any of the cited references of the execution of a risk model, let alone a risk model as further defined by various dependent claims, or a risk model directed to disaster recovery process. Without such objective evidence, along with a reasonable rationale to modify primary reference Alexander to perform this step of executing a risk model at least one time, the rejection of record fails to establish a *prima facie* obviousness rejection for even the independent claims.

Moreover, the conversion of the method of Alexander into a computerized tool that executes a risk model at least one time would clearly change the principle of operation of the method described in Alexander and the conversion would clearly defeat the intended purpose of Alexander, since Alexander's intended purpose is to collect and analyze data and present this integrated data to emergency management agencies.

Such change in principle of operation is improper under the holding of *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), as described in MPEP §2143.01: "*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.*" Moreover, the conversion that defeats the purpose of Alexander is improper under the holding of *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), as also described in MPEP §2143.01: "*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*"

Therefore, because of the holdings in *Ratti* and *Gordon*, the rejection of record fails to establish a *prima facie* rejection for even independent claim 1.

Hence, turning to the clear language of the claims, in Alexander there is no teaching or suggestion of "A method of calculating a risk exposure for a disaster recovery process, ... and executing, at least one time, one of said risk models", as required by independent claim 1. The remaining independent claims have similar language and/or concepts. Therefore, all claims are clearly patentable over Alexander and the Examiner is respectfully requested to reconsider and withdraw these rejections based on primary reference Alexander.

However, Applicants respectfully submit that the Examiner's position is further

flawed in fundamental ways, as follows.

First, the Examiner's reliance in paragraph 33 beginning on page 18 of the Office Action on *In re Van Geuns* is improper and factually incorrect, since the final claim limitation of independent claim 1 sufficiently defines the method as set out in the claim preamble. However, in an attempt to expedite prosecution, Applicants have amended this final limitation in an attempt to accommodate the Examiner's viewpoint that the wording of the preamble is not carried over into the limitations.

Second, the Examiner's reliance on *In re Keller* is misplaced because the facts of *Keller* are not present in the evaluation of the present application. In *Keller*, the words from that holding upon which the Examiner relies were based upon a fact pattern in which Keller presented evidence that attacked only one of two cited references and failed to address the contents of the second, more significant reference. The issue in *Keller* was whether a digital timer would be obvious to incorporate into a heart pacer, given that the heart pacer circuit was known in the art as including an analog timer and the secondary reference demonstrated the use of a digital timer in another type of heart device. The Court held that the two references were properly combinable, so that the Examiner in *Keller* had established a *prima facie* obviousness rejection, thereby shifting the burden to Keller to rebut. The Court held that Keller failed to meet his burden to rebut the rejection since his evidence failed to address the secondary reference.

These facts underlying *Keller* are not present in the present evaluation, since the holdings of *Ratti* and *Gordon* clearly demonstrate that the rejection of record has failed to establish a *prima facie* rejection. Moreover, Applicants are not failing to address any of the cited references in their reply, unlike the facts of *Keller*.

Third, the Examiner's reliance on secondary reference Benbassat is also misplaced, since this reference is clearly not related to disaster recovery, let alone providing a model that simulates a disaster. Accordingly, in order to use this secondary reference in the evaluation of the claimed invention for even independent claim 1 alone, the Examiner has the initial burden to convert the method of assigning human resources to provide services into the completely unrelated method for "... executing, at least one time, one of said risk models", as required by claim 1. The holdings of both *Ratti* and *Gordon* clearly preclude this conversion for purpose of evaluating the present invention.

Stated slightly differently, the fundamental flaw in the evaluation currently of record is that the Examiner attempts to take words out-of-context of the environments of the cited

references, thereby improperly ignoring that neither Alexander nor Benbassat reasonably has anything whatsoever to do with the method described in the claimed invention. This attempt to take prior art references as arbitrary abstract ideas does not satisfy the requirement in *KSR* that the Examiner has the initial burden to provide a reasonable rationale to modify the teachings of primary reference Alexander to arrive at the claimed invention.

Applicants' previous remarks are considered as maintained, relative to the rejection based on Alexander and the invocation of Official Notice.

Therefore, claims 1-23 are clearly patentable over Alexander and the Examiner is respectfully requested to reconsider and withdraw these rejections.

Relative to the new rejection for claim 24, based on new secondary reference Tremain, this newly-cited reference fails to overcome the deficiencies identified above for independent claim 1. It is further noted that the Examiner's legal basis for this rejection is legally incorrect. The Examiner has the initial burden of articulating a reasonable rationale to modify primary reference Alexander. The Examiner's statement that obviousness is inherent if well-known elements are combined is not the correct legal standard. As pointed out above, modification of primary reference Alexander would be improper under the holding of *Ratti* and *Gordon*.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-24, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/629,869
Docket No. YOR920010432US1(YOR.314)

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via EFS this Amendment under 37 CFR §1.116 to the USPTO on April 3, 2009.



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